

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEApplicant(s): Paul BEINAT *et al.*

Application No.: 09/539,218

Art Unit: 3626

Filed: March 30, 2000

Examiner: Frenel, Vanel

For: CLAIM ASSESSMENT MODEL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

A notice of appeal is filed herewith. Applicants respectfully request review of the June 6, 2006 Office Action in the above identified application.

The current status of the case is as follows. Applicants filed an Amendment with a Request for Reconsideration (RCE) on March 13, 2006. Claims 1, 3-16, 18-31, 33-69 and 71-87 are pending on appeal as shown in the March 13, 2006 Amendment, claims 1, 16, 69, 77, 78, and 87 being independent in form. Applicants received the Office Action in response on June 6, 2006.

The Examiner rejected claims 1, 3-8, 10-16, 18-31, 33-76, and 87 under 35 U.S.C. §103(a) over four references: DeTore *et al.* (U.S. Patent No. 4,975,840), Seare *et al.* (U.S. Patent No. 6,223,164), and Joao (U.S. Patent No. 6,283,761) in view of Dormond *et al.* (U.S. Patent No. 4,839,822). The Examiner rejected claims 77-86 under 35 U.S.C. §103(a) over DeTore *et al.* (U.S. Patent No. 4,975,840), Seare *et al.* (U.S. Patent No. 6,223,164), Joao (U.S. Patent No. 6,283,761), and Dormond *et al.* (U.S. Patent No. 4,839,822) as applied to claims 1-76, and further in view of a fifth reference, Hammond *et al.* (5,613,072).

I. The Examiner Has Failed To Provide A *Prima Facie* Case Of Obviousness

Applicants disclose a computerized method for automatically determining worker's compensation insurance or common law claim payout estimates by assessing the conditions affecting an impaired person to determine the impact of said conditions on the impaired person.

The assessment is made, at least in part, by estimating the dysfunction or capacity of at least one body part from the time of injury over a specific *progressive time scale into the future*. (See independent claims 1, 16, 31, 69, 77, 78, and 87).

In contrast, the prior art cited in the June 6, 2006 Office Action discloses the following:

DeTore et al. is generally directed to determining the insurability of an insurable risk, i.e., determining the probabilities surrounding the likelihood of a payout and, therefore, the amount of premium that must be charged. (DeTore at col. 1, lines 7-58).

Seare et al. is generally directed to a system for "analyzing medical claim histories and billing patterns to statistically establish treatment utilization patterns for various medical services." (Seare at col. 1, lines 25-28). Specifically, the system is used to determine whether doctors are over utilizing or under utilizing services as compared to a historical statistical profile. (Seare at col. 5, lines 38-44). The system is, therefore, used to identify doctors that provide treatments that do not fall within statistically established treatment patterns. (Seare at col. 27, lines 30-43).

Joao is generally directed to a healthcare related information processing system. (Joao at col. 2, lines 30-36). The system can manage information between patients, doctors, other healthcare providers, and insurance and/or payment providers. (Joao at col. 2, lines 37-45). While the Joao does disclose that it can be used to claim disability benefits (Joao at col. 10, lines 45-49), it only discloses this in connection with preparing the forms/information required by the insurance provider when making a claim. (Joao at col. 37, lines 10-35).

Dormond et al. is generally directed to an expert system for the treatment of trauma. (Dormond at col. 1, lines 13-15). Specifically, the disclosed system provides a set of recommended treatments for particular physical conditions. (Dormond at col. 17, lines 45-60).

Hammond et al. is generally directed to forecasting funding requirements for workers' compensation insurance providers' reserve accounts. (Hammond at col. 1, lines 11-18; col. 3, lines 30-41).

A. The Cited References Fail To Disclose All Of The Limitations Of The Pending Claims

The cited prior art does not disclose a number of the limitations recited in the pending claims. There is not sufficient space in this five page Request For Review to address each

instance where the cited references fail to show the limitation identified by the Examiner. Accordingly, Applicants will demonstrate *some* of the representative errors in independent claim 87, which necessitate withdrawal of the Examiner's rejection.

First, claim 87 limitation (a)(i) requires one or more databases comprising:

a multiple-level hierarchical model of the human body, including a plurality of body parts... wherein each body part is associated as a component of one or more other body parts and wherein each body part has associated component functionality values that indicate the body parts' importance to each of the one or more other body parts of which the body part is a component

The Examiner purports to find this limitation in Dormond at col. 16, line 58 - col. 17, line 44. (June 6, 2006, Office Action at 33). The cited portion of Dormond, however, does not disclose a multiple-level hierarchical model of the human body. Instead, the cited portion of Dormond discloses a "hierarchy of suggested treatments" to be performed on a patient, such as "internal," "joint replacement," or "hip prosthesis." (Dormond at col. 16, lines 58-61; col. 17, lines 3-10). To the extent that Dormond does not disclose a model where the body parts are components of other parts, Dormond also does not disclose a model that lacks the further aspect of limitation (a)(i), which requires "component functionality values that indicate the body parts' importance to each of the one or more other body parts of which the body part is a component."

Second, claim 87 limitation (a)(ii) requires the one or more databases to further comprise:

a plurality of medical condition profiles associating a transient medical condition, one or more body parts affected by the transient medical condition and one or more temporally variable dysfunction values indicating the relative affect of the transient medical condition on each of the one or more body parts over a range of times

The Examiner purports to find this limitation in Joao at col. 38, lines 18-51. (June 6, 2006, Office Action at 33). The cited portion of Joao, however, does not disclose a database containing medical condition profiles associating a transient medical condition and one or more body parts with temporally variable dysfunction values that indicate the effect of the medical condition on the body part over time. Instead, the cited portion of Joao generally discloses a function that provides for a training simulation that evaluates the likelihood of success or complications arising from a suggested treatment. (Joao at col. 38, lines 18-51). Moreover,

there is no suggestion in Joao that the simulation computes the effects of a medical condition on a body part over "a range of times." In addition, Joao only describes this feature functionally without any detail regarding the type or content of the databases that might be employed to create this function.

B. The Examiner Has Failed To Provide A Sufficient Motivation To Combine The References

The Examiner has also failed to provide an adequate motivation to combine the five disparate references combined to allegedly show obviousness. Generally, for each obviousness rejection the Examiner asserts a motivation to combine by simply reciting one of the reference's stated objects of the invention. The Examiner, however, offers no explanation as to how the referenced object of the invention motivates one to make the asserted combination.

By way of example, the Examiner asserts that independent claim 87 of the pending application is obvious over the combination of DeTore, Seare, Joao, and Dormond. The Examiner's stated motivation for the combination is:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included the collective features of DeTore, Seare and Joao within the system of Dormond with the motivation of providing an expert system for the specific field of orthopedic trauma (See Dormond, Col. 2, lines 31-33).

(June 6, 2006 Office Action at 34). The cited passage of Dormond simply states that "[i]t is a further object of the present invention to provide an expert system for the specific field of orthopedic trauma." One exemplary limitation of claim 87 that the Examiner alleges is shown by DeTore and for which the Examiner asserts the quoted passage creates a motion to combine is "generating and outputting an insurance compensation value...." The Examiner provides no justification as to why the insurance compensation value alleged to be shown by DeTore should be combined with Dormond's system for recommending treatments for orthopedic trauma. Nor is there any other discernable reason to make such a combination.

While claim 87 was used by way of example, the Examiner's purported motivations to combine the references applied to the other claims are similarly lacking. For example, with regard to independent claims 1, 16, 31, and 69 the Examiner asserts the motivation for combining DeTore, Seare, Joao, and Dormond as described above with regard to claim 87 and further asserts a motivation to combine DeTore, Seare, and Joao based on a statement in Joao


that it is an object of the Joao invention to provide "healthcare information which can be utilized to find and/or locate supplies, body organs, blood, medications, and/or any other goods, products, and/or supplies." (Joao, Col. 10, lines 3-7). The Examiner, however, provides no basis or logical reason why Joao's object of locating medical supplies would motivate a person of skill in the art to combine Joao with features of the insurance premium analysis system of DeTore and the insurance usage auditing system of Seare. With regard to independent claims 77 and 78, the Examiner similarly uses an object of Hammond, namely the determination of appropriate loss reserves, as motivation to combine Hammond, DeTore, Seare, Joao, and Dormond. Once again, the Examiner's mere recitation of an object of the one of the cited references is insufficient to provide a motivation to combine those references.

CONCLUSION

The reasons cited above demonstrate the errors present in the pending Office Action and the basis for reversal on appeal. For these reasons Applicants respectfully request withdrawal of the pending rejections and allowance of the application.

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 12941-200. In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 12941-200.

Dated: September 6, 2006

Respectfully submitted,
 CHADBOURNE & PARKE, L.L.P.
 By: 
 Richard Martinelli
 Registration No. 52,003

Correspondence Address:

CHADBOURNE & PARKE, L.L.P.
 30 Rockefeller Plaza
 New York, NY 10112
 212-408-5100 Telephone
 212-541-5369 Facsimile